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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/641,645	08/18/2000	Axel Burmeister	Beiersdorf 642-WCG	6935

7590

04/26/2002

Norris McLaughlin & Marcus PA  
220 East 42nd Street  
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New York, NY 10017

EXAMINER
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MICHL, PAUL R

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/26/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

MF 10

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Berejka or Chiu or Medsker or Kelley. Applicants' claims are directed to compositions comprising elastomer, tackifier, and phenolic resins having methylol groups. Berejka, Chiu, Medsker, and Kelley all disclose phenolic resins having methylol groups. See column 5, lines 50-62 of Berejka. See column 7, lines 52-60 of Chiu. See columns 2 and 3 of Medsker. See column 13, lines 52-64 of Kelley. All of these references disclose elastomers and tackifying resins. It would be obvious to one of ordinary skill in the art to formulate adhesive compositions comprising elastomer, tackifying resin, and the required phenolic resin having methylol groups. The motivation is that elastomers and tackifying resins are conventional ingredients in adhesive compositions and it would be within the skill of one in the art to formulate adhesive compositions comprising elastomer, tackifying resin, and the

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required phenolic resin within the context of Berejka or Chiu or Medsker or Kelley.

Claims 1-12 are rejected under 35 U.S.C. § 112 second paragraph because the phrase "tackifying resin" fails to particularly point out and distinctly claim what applicants consider the invention to be. The claimed phenolic resin having methylol groups itself qualifies as a tackifying resin. Therefore, the claimed "tackifying resin" encompasses the claimed phenolic resin. When the claimed phenolic resin is present in the composition as the tackifying resin, the composition becomes a two component composition of elastomer and phenolic resin. Applicants do not consider two component compositions to be the invention. Since there is a genus-species relationship between the claimed tackifying resin and the claimed phenolic resin, the claimed "tackifying resin" fails to particularly point out and distinctly claim what applicants consider to be the invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Michl whose telephone number is (703) 308-2451. The examiner can normally be reached on Monday through Friday from 7:30 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be

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reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

PRMichl:cdc

April 23, 2002



**PAUL R. MICHL**  
**PATENT EXAMINER**  
**ART UNIT 156**